

REMARKS

This communication responds to the Office Action mailed on August 20, 2007. Claims 1-5, 12-14 and 40 are amended, no claims are canceled, and no claims are added; as a result, claims 1-5, 12-17 and 40-43 are now pending in this Application.

§102 Rejection of the Claims

Claims 1, 2 and 4 were rejected under 35 U.S.C. § 102(b) for anticipation by McAndrew (U.S. Patent No. 6,066,402). The Applicant does not admit that McAndrew is prior art and reserves the right to swear behind this reference at a later date. In addition, because McAndrew does not disclose the identical invention claimed, Applicant respectfully traverses this rejection.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Amended independent claim 1 recites “a second lead finish disposed over the component lead including a first amount between about 80% to about 93% by weight of lead, a second amount between about 2% to about 12% by weight of silver, and a third amount of tin”.

Applicant respectfully submits that McAndrew does not anticipate “**a second lead finish disposed over the component lead** including a first amount between about 80% to about 93% by weight of lead, a second amount between about 2% to about 12% by weight of silver and a third amount of tin (emphasis added).” Thus, a *prima facie* case of anticipation has not been established, and claim 1 should be in condition for allowance.

Additionally, claims 2 and 4 further depend on allowable independent claim 1 and for at least the above reasons should also be allowable. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 1, 2 and 4 under 35 U.S.C. §102.

§103 Rejection of the Claims

Claims 3 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over McAndrew (U.S. Patent No. 6,066,402) in combination with the applicant's admitted prior art (AAPA) of this application.

Claims 12, 13, 14, 15, 16 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over McAndrew (U.S. Patent No. 6,066,402) in combination with the applicant's admitted prior art (AAPA) of this application.

Claims 40, 41, 42 and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shimizu et al. (Publication No. 59085395) in combination with McAndrew (U.S. Patent No. 6,066,402) and the applicant's admitted prior art (AAPA) of this application.

Since a *prima facie* case of obviousness has not been established by the Office, the Applicant respectfully traverses.

1) The Applicable Law

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, three basic criteria should be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d, 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Additionally, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. See *KSR Int'l Co.*, p. 14, citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006); *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

Furthermore, the Court in *KSR* reaffirmed that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. See also *Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474.

2) *Application of § 103 to rejected claims - Combining the References Does Not Supply All Claimed Elements:*

Claims 3 and 5

Claims 3 and 5 depend directly from patentably distinct independent claim 1 and are therefore allowable. Furthermore, it is respectfully noted that if an independent claim is nonobvious under 35 USC § 103 then any claim depending therefrom is also nonobvious. See *M.P.E.P.* § 2143.03. Thus, the rejection of claims 3 and 5 under 35 U.S.C. §103(a) is improper.

Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 3 and 5 under 35 U.S.C. §103.

Claim 12-17

Amended independent claim 12 recites in part, “a component lead having a second lead finish disposed over the component lead, the second lead finish including a first amount between about 80% to about 93% by weight of lead, **a second amount between about 2% to about 12% by weight of silver**, and a third amount of tin (emphasis added).” Applicant respectfully disagrees with the Examiner and states that neither McAndrew nor any applicant admitted prior art alone or in combination discloses the above elements. A *prima facie* case of obviousness has not been established with respect to independent claim 12. Applicant believes claim 40 is in condition for allowance.

Dependent claims 13-17 further defines patentably distinct independent claim 12. As a result, dependent claims 13-17 are also believed to be allowable. Therefore, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §103 rejection to claims 12-17 and request allowance of these claims.

Claims 40-43

With respect to claim 40, the Office Action states that Shimizu teaches a composition including 97.5% weight of lead, 1.5% weight of silver and a balance of tin. The Office Action also states that McAndrew teaches a lead solder layer or coating or finish having 83 to 87 percent weight of lead. Moreover, the Office Action goes on to state that McAndrew fails to teach the weight percent of lead is about 78% to 82.9%. However, a close reading of the references reveals that no combination of Shimizu and McAndrew suggested in the Office Action renders all the claim elements of currently amended independent claim 40.

Claim 40 recites in part, “composition including a **first amount between about 78% and about 82% by weight of lead**, a second amount between about 9% and about 11% by weight of antimony, **a third amount between about 3% and about 12% by weight of silver**, and a balance of tin (emphasis added).” Applicant respectfully disagrees with the Examiner and states that neither Shimizu nor McAndrew alone or in combination discloses the above elements.

A *prima facie* case of obviousness has not been established with respect to independent claim 40. Applicant believes claim 40 is in condition for allowance.

Dependent claims 41-43 further defines patentably distinct independent claim 40. As a result, dependent claims 41-43 are also believed to be allowable. Therefore, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §103 rejection to claims 40-43 and request allowance of these claims.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2103 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date: February 19, 2008

By _____



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19th day of February 2008.

PATRICIA A. HULTMAN

Name



Signature